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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,352	10/03/2003	Carlos E. Collazo	OSTEONICS 3.0-466	1797
530 7590 07/09/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER WILLSE, DAVID H	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 07/09/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/678,352	COLLAZO, CARLOS E.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dave Willse	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,6-11,13,14,32,33 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6-11, 13, 14, 32, 33, and 35-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 6-11, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 7, “complementary” is misspelled; on line 13, “that”, second occurrence, should be deleted. In claim 14, line 2, the term “orthopedic implant trial” is not found in claim 1 or claim 13, and claim 14 does not appear to further limit claim 13.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6-11, 13, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Freid et al., US 2004/0019353 A1, as evidenced by Gabriel, US 5,571,194. In view of the dimensions specified by Freid et al. in paragraphs 0091 through 0093 and the comparable dimensions taught in Gabriel at column 6, lines 42-54, the Freid et al. plate system is *capable* of engaging a complementarily sized bone-facing cavity in a condylar portion of a trial distal

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femoral component, even though such was not the intent. The Freid et al. drawings illustrate a first block **32** including at least one channel (Figures 2, 6, 10, 11, etc.), a second block **34** with at least one complementary surface for sliding movement with a respective channel, and an expansion member comprising couplings, serrations, and the like, such that the blocks are able to move away from one another (paragraphs **0011**, **0018**, **0102**, etc.). Regarding claims 13 and 14, a surgical tray would have been inherent in order to facilitate access to the plates, fasteners, plate insertion instrument (Figures 7 and 8), and other items associated with the disclosed surgical procedure.

Claims 1, 4, 6-11, 13, 14, 32, 33, and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sevrain et al., WO 01/89428 A2, in view of Freid et al., US 2004/0019353 A1, as evidenced by Gabriel, US 5,571,194. The Sevrain et al. embodiment depicted in Figures 2A-2E is *capable* of engaging a complementarily sized bone-facing cavity in a condylar portion of a trial distal femoral component, even though such was not the intent, in view of Figure 29 of Freid et al. and the teachings on typical dimensions referenced above. The Sevrain et al. embodiment also includes a spring for biasing the blocks **30** and **32** in opposite directions (page 11, lines 31-34) and a stop member to prevent complete separation of the blocks (page 11, lines 27-30). Regarding claims 11 and 39, a stop member pin would have been obvious from pin **120** in Figure 11 of Freid et al. (paragraph **0102**), with both embodiments being similar in design and function (Sevrain et al.: page 11, lines 19-27).

The Applicant's remarks have been considered but are deemed to be moot in view of the new grounds of rejection presented above. In order to advance prosecution, the examiner will permit the Applicant to shift election of inventions from the subcombination drawn to an

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orthopedic trial augment to a combination which positively recites as elements the orthopedic trial augment *and* the trial distal femoral component, if the Applicant so desires.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is 571-272-4762 and who is generally available Monday, Tuesday, and Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

**/Dave Willse/  
Primary Examiner  
Art Unit 3738**